



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,886	02/03/2004	Satoshi Sembo	600630-14US (563044)	1038
570	7590	03/22/2006		EXAMINER
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			STITZEL, DAVID PAUL	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/770,886	SEMBO, SATOSHI
	Examiner	Art Unit
	David P. Stitzel, Esq.	1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 December 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-9 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

OFFICIAL ACTION

Acknowledgement of Receipt

Receipt of the Applicant's Response, to the Official Action dated September 9, 2005, which was filed on December 8, 2005, is acknowledged.

Status of Claims

Claims 1-9 are currently pending and therefore examined herein on the merits for patentability.

Claim Rejections - 35 U.S.C. § 102

1. The rejection of claims 1-9 under 35 U.S.C. § 102(a) as being anticipated by U.S. Pre-Grant Patent Application Publication Number 2002/0115565 (hereinafter the Asrar '565 publication) is withdrawn in view of Applicant's arguments.
2. The rejection of claims 1-9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,218,416 (hereinafter the Sembo '416 patent) is withdrawn in view of Applicant's arguments.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 103, which forms the basis of the obviousness rejections as set forth under this particular section of the Official Action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pre-Grant Patent Application Publication Number 2002/0115565 (hereinafter the Asrar ‘565 publication) in view of U.S. Patent 6,218,416 (hereinafter the Sembo ‘416 patent).

With respect to claims 1-9 of the instant application, the Asrar ‘175 publication teaches a method of controlling pests with an insecticidal composition comprising an oxadiazine derivative and a pyrethroid compound, namely imiprothrin; wherein the ratio of said oxadiazine derivative to imiprothrin is within the range of 1:1000 to 1000:1; wherein said pests are any insect or other pest that feeds on seed, root or foliage of a plant, said pests including, without limitation, mosquitoes, flies and ants (abstract, [0018]-[0019], [0023]-[0025], [0030]-[0032], [0034]-[0036], [0047], [0053], [0073]-[0076], [0085] and claims 1-3, 5 and 6). The Asrar ‘175 publication does not explicitly teach “indoxacarb” as being the oxadiazine derivative within the insecticidal composition. However, the Sembo ‘416 patent teaches a method of controlling agricultural pests with a pesticidal composition comprising: a guanidine derivative; an oxadiazine compound, namely “indoxacarb;” and a pyrethroid compound, namely imiprothrin (a.k.a., [2,5-dioxo-3-(2-propynyl)-1-imidazolidinyl]methyl chrysanthemate); wherein said pests are of the phylum Arthropoda and are selected from the group consisting of mosquitoes, flies, termites, ants and cockroaches (abstract; column 1 in its entirety; column 4 in its entirety; column 6, lines 7-11 and 39-47; column 7, lines 19-32, 52-56 and 59-62; and column 8, lines 6-25).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the instant application was filed to modify the insecticidal composition of the Asrar ‘175 publication to include indoxacarb, together with the imiprothrin pyrethroid compound, as the oxadiazine derivative therein, so as to provide additive and/or synergistic effects to said insecticidal

composition, as reasonably suggested by the Sembo '416 patent (column 4, lines 1-30). One of ordinary skill in the art at the time the instant application was filed would have been motivated to modify the insecticidal composition of the Asrar '175 publication to include indoxacarb, together with the imiprothrin/chrysanthemate pyrethroid compound, as reasonably suggested by the Sembo '416 patent, since indoxacarb is an oxadiazine derivative having similar utilities and properties, namely pest repellent activity, to that of the oxadiazine derivatives of the Asrar '175 publication, namely insecticidal activity. One of ordinary skill in the art at the time the instant application was filed would have had a reasonable expectation of success to include the indoxacarb compound of the Sembo '416 patent as the oxadiazine derivative within the insecticidal composition of the Asrar '175 publication, since indoxacarb, being an oxadiazine derivative in and of itself, is structurally similar to the oxadiazine derivatives of the Asrar '175 publication.

With respect to claims 1-4 of the instant application, although the Asrar '175 publication teaches a method of controlling pests with an insecticidal composition comprising an oxadiazine derivative, such as indoxacarb as taught by the Sembo '416 patent, and an imiprothrin pyrethroid compound, wherein the ratio of said oxadiazine derivative to imiprothrin is within the range of 1:1000 to 1000:1 (abstract, [0018]-[0019], [0023]-[0025], [0030]-[0032], [0034]-[0036], [0047], [0053], [0073]-[0076], [0085] and claims 1-3, 5 and 6), the Asrar '175 publication fails to explicitly teach the instantly claimed ratio range of 50:1 to 1:10, and more specifically of 20:1 to 1:4, of an indoxacarb oxadiazine derivative to an imiprothrin pyrethroid compound. However, while the Asrar '175 publication does not explicitly teach the instantly claimed ratio ranges of said indoxacarb oxadiazine derivative to said imiprothrin pyrethroid compound, it is well within

the purview of the skilled artesian to determine the optimal ratio range of said indoxacarb oxadiazine derivative to said imiprothrin pyrethroid compound by systematically adjusting the concentrations and ratio ranges thereof during the course of routine experimentation. One of ordinary skill in the art at the time the instant application was filed would have been motivated to systematically adjust the ratio ranges of said indoxacarb oxadiazine derivative to said imiprothrin pyrethroid compound during the course of routine experimentation so as to obtain a desired insecticidal, pesticidal and pest repellent activity. “Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). “The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.” See *Peterson*, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003).

Examiner’s Response to Applicant’s Remarks

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new grounds of rejection set forth hereinabove. Because a new grounds of rejection is made as set forth hereinabove, the instant Official Action is made **NON-FINAL**.

Conclusion

Claims 1-9 are rejected.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David P. Stitzel, Esq. whose telephone number is 571-272-8508. The examiner can normally be reached on Monday-Friday, from 7:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Kunz can be reached at 571-272-0887. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David P. Stitzel, Esq.



SREENI PADMANABHAN
SUPERVISORY EXAMINER